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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/937,151	01/15/2002	Jurgen Strube	2234/50345	6157

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EXAMINER

GOLLAMUDI, SHARMILA S

ART UNIT	PAPER NUMBER
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1616

DATE MAILED: 10/12/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary

Application No.

09/937,151

Applicant(s)

STRUBE ET AL.

Examiner

Sharmila S. Gollamudi

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 July 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 6-8 and 12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 6-8 and 12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Receipt of Amendments and Remarks received on July 27, 2004 is acknowledged. Claims 6-8 and 12 are pending in this application. Claims 1-5 and 9-11 stand cancelled.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 6-8 and 12 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Applicant has changed the word "potentiating" to "potentiated" which does not find support in the instant specification. The applicant stated in the Arguments of 12/20/03 that the potentiating was incorrectly translated. The examiner noted the change in terminology and withheld a rejection based on new matter, warning the applicant to provide a translated document to provide support to obviate a new matter rejection. However, applicant has not done so and thus the examiner has rejected the claims under new matter and is entitled make this action final since the applicant was explicitly told that a foreign translation is required to avoid a new matter rejection.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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Claims 6-7 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 6-7 recites that the amino acids are produced by adding distilled alcohol; this is indefinite since it is unclear how a fruit alcohol contains amino acids. Further clarification is requested.

Response to Arguments

Applicant argues that under the accepted theories of homeopathic medicine, the amino acids present are impurities derived from air-borne or water-borne sources.

Applicant's arguments have been fully considered but they are not persuasive.

Although the examiner is not questioning the homeopathic theories or medicine, applicant's definitions of the instant terms is repugnant to the conventional, textbook definition and a skilled artisan would not readily ascertain the scope of the claims. The conventional and accepted terminology of alcohol does not include amino acids in the chemical structure. It should be noted that upon reading the specification, applicant states that distilled alcohol is not used since they are purified and do not contain the requisite amino acids. However, claim 6 recites utilizing distilled fruit alcohol. Therefore, the rejection of the claims as being indefinite is maintained. If applicant submits literature supporting the theories then the rejections will be reconsidered; however without evidence supporting such statements, the examiner relies on established scientific data. It should be noted that the applicant has not submitted the non-patent literature that has been cited to support the applicant's assertions.

Claim Rejections - 35 USC § 103

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The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 6-8 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nelson et al (5,603,915).

Nelson et al disclose a process for manufacturing homeopathic medicines by contacting the homeopathic medicine with a carrier solution (potentising agent) containing alcohol, water, seawater, brain hormone and biologically active enzymes. See abstract and examples. Nelson teaches the conventional use of water and alcohol as carrier solutions in homeopathic medicine. Further, Nelson discloses a method of preparing a homeopathic medicine with Nx potency by adding one part active and nine parts of the carrier solution and dispersing the active in the solution. The solution is diluted to the required potency by repeating the step. See column 2, lines 42-67.

Nelson et al do not specify the source of the alcohol.

It is deemed obvious to one of ordinary skill in the art at the time the invention was made to look to Nelson et al and his disclosed conventional homeopathic practices and utilize the desired alcohol. One would be motivated to do so since Nelson teaches the conventional practice of utilizing alcohol as the potentiating agent in homeopathic medicine. Although, the source of the alcohol is not specified, the source per se of the alcohol does not impute patentable difference to claims unless the applicant can provide unexpected results demonstrating that the source *itself* compared to other types of alcohol provides the requisite result. Furthermore, since the critical feature of the invention itself, i.e. the amino acids, are contained in the Nelson's potentiating medium, it is the examiner's position that the alcohol does not impute a patentable difference.

Response to Arguments

Applicant's arguments have been fully considered but they are not persuasive.

Applicant argues Nelson utilizes pure alcohol and it is well known that alcohol from fruit or grain is not pure at all.

The examiner notes that Nelson uses 200 proof alcohol; however the examiner points out that the claims do not require that the alcohol is impure. Therefore, applicant is relying on a feature that is not in the claims.

More over, the examiner points out that applicant's arguments of December 30, 2003 and July 27, 2004 state that it is "well-known that impurities contaminate various liquids like water or alcohol from the air" and applicant's specification on page 3 states that "when transferring the potentiating medium in air, additional amounts of air-borne free and bound amino acids are taken up by the potentiating medium". It is clear that per applicant's own admission, any medium that is exposed to air will inherently have amino acids; thus Nelson's alcohol must

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contain the requisite amino acids per applicant's logic since Nelson does not perform the dilutions in a vacuum.

Secondly, the applicant has not addressed the novelty of the source of the alcohol, thus it is the examiner's position that the source of the alcohol does not impute a patentable difference.

Therefore the rejection is maintained.

Conclusion

None of the claims are allowed at this time

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sharmila S. Gollamudi whose telephone number is 571-272-0614. The examiner can normally be reached on M-F (8:00-5:30), alternate Fridays off.


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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Kunz can be reached on 571-272-0887. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Sharmila S. Gollamudi
Examiner
Art Unit 1616

SSG


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